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AMENDMENT

Remarks

In the Office Action mailed July 14, 2006, the Examiner: (i) rejected claims 1, 12, 13, 20 under 103(a) unpatentable over U.S. Patent No. 5,631,984 to Graf ("Graf") in view of U.S. Patent No. 5,570,435 to Bloomberg ("Bloomberg"); (iii) rejected claims 8, 9, 11, and 18 under 35 U.S.C. 103(a) as unpatentable over Graf in view of Bloomberg and Reference U ("Gonzalez"); (iv) rejected claims 15 and 17 under 35 U.S.C. 103(a) as unpatentable over Graf in view of Bloomberg, U.S. Patent No. 5,982,502 to Jinnai ("Jinnai"), Microsoft Corporation Word 10 ("Word 10," a.k.a. Word 2002); (v) rejected claim 10 under 35 U.S.C. 103(a) as unpatentable over Graf, Bloomberg, Gonzales, and Word 10; (vi) rejected claim 19 under 35 U.S.C. 103(a) as unpatentable over Graf, Bloomberg, Jinnai, and Word 10; (vii) rejected claims 2 and 4 under 35 U.S.C. 103(a) as unpatentable over Graf, Bloomberg and U.S. Patent No. 6,980,331 to Mooney ("Mooney"); and (vi) rejected claims 4, 5, 6, and 7 under 35 U.S.C. 103(a) as unpatentable over Graf, Bloomberg, Mooney, and Word 10.

In response, Applicant has amended claims 1, 2, 8, 9, 14, and 18-20, and canceled claims 3, 10, and 16. Claims 1-2, 4-15, and 17-20 will be pending after entry of this Amendment.

I. Rejections under Sections 102 and 103

Applicant has heavily amended the claims to include features described with reference to Figs. 2D-2G. The inventions described in the claims, as amended, now include language requiring a plurality of copies of a paper document, such as subsequent drafts of a document or copies of the same document circulated for review.¹ The claims also require the ability to

¹Claims 1 and 20 ("receiving a plurality of copies of a paper document"); claim 13 ("a scanner for capturing pages from a plurality of drafts of a document"); and claim 19 ("a scanner for capturing a digital image a page from multiple copies of a document").

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generate notation summary information that is in some way cognizant of the plurality of copies.² None of the references teach or suggest claimed acts of receiving multiple copies of the same paper document or of generating the claimed notations.

1. Graf

Graf is directed at a system for segmenting and compressing electronic images of documents, particularly checks. Although Graf claims that this system can be used in a wide variety of other document-related applications, the system is fundamentally directed at the problem faced by banks, namely, to quickly capture large numbers of unrelated documents. The present invention, in contrast, is directed at a fundamentally different problem.

As explained in the background section of the present application, teams of employees frequently need to cooperatively prepare and review documents in the modern workplace. Inevitably, these group projects require that documents be copied multiple times for distribution, for review and re-review, and to create a record of changes. Unfortunately, this process spreads the editorial comments across the multiple copies of the document. Thus, to find all of the changes and/or to retain a record of who made what changes, someone must sort through multiple copies of the document, then extract those pages with comments, then feed those pages into the copier and/or enter the changes into a computer, then re-insert the pages back into the originals. This process is time consuming and, invariably, results in some lost comments. Moreover, as documents are serially reviewed, it becomes difficult to identify and focus upon new comments.

² *Claims 1 and 20* (“generating notation summary information, comprising: printing the first image only if the first image contains at least one handwritten notation; and printing the second image only if the second image contains at least one handwritten notation”); *claim 13* (“a processor configured to determine whether the captured page contains a new handwritten notation and configured to print the image only if the image contains at least one new handwritten notation”); and *claim 19* (“wherein the programmable processor is programmed to detect handwritten comments on the least one page and to selectively: determine if the handwritten comment is new”).

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The present invention solves these problems by providing a way to collate documents with changes, index changes as part of a copy job, create side markings as part of a copy job, and/or compare reviewer comments and handwritten additions in the copier job compared to archived documents. In addition, the present invention allows reviewers to work with plain paper and with conventional writing instruments, such as a pencil or ballpoint pen.

With these fundamental differences in mind, Applicant respectfully submits that Graf fails to teach or suggest both scanning a plurality of copies of a paper document and generating notation summary information that is in some way cognizant of the plurality of copies.

2. Bloomberg

Bloomberg is primarily directed at a method for locating type styles, such as bold and italic type styles. *Bloomberg, col. 2, lines 16-24.* The results of this analysis can be used in automatic database indexing of scanned images in which bold and italic styles would be used to directly and automatically generate keyword indices, or to produce copies of a black and white document in which portions in bold or italic are reproduced in color. *Id.* Bloomberg also includes a method for identifying and separating handwritten annotations and machine printed text in an image or document. *Id. at col. 3, lines 35-43.* Bloomberg teaches that this method allows the handwritten portions to be removed, while retaining machine printed text or, conversely, for the machine printed text to be removed, while retaining the handwritten annotation. *Id. at col. 8, lines 47-53.*

As a result of this focus, Bloomberg fails to contemplate situations where the key information is the interaction of the handwritten portions and the machine written portions. Thus, Bloomberg also fails to teach or suggest the claimed acts of scanning a plurality of copies of a paper document and generating notation summary information that is in some way cognizant of the plurality of copies.

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3. Word 10

In view of the Examiner's comments in paragraph 2 of the Office Action dated April 19, 2006, Applicant will assume that the Examiner is relying on information in Word 9. If this is incorrect, Applicant requests that the Examiner provide an exact publication date for the reference. Because Applicant's filing date is January 16, 2002, a Rule 1.131 Affidavit may be appropriate.

The Word 10 reference also fails to teach or suggest these elements. Instead, References U and V simply teach that Microsoft Word 2002 had a feature where you could track changes in an electronic document. There is no teaching of tracking changes to physical documents, much less scanning a plurality of copies of a paper document and generating notation summary information that is in some way cognizant of the plurality of copies.

4. Gonzales

Gonzales also fails to teach or suggest these elements. Instead, Gonzales (as best understood, the supplied copy is missing a portion of each line) simply teaches that you can detect motion by comparing frames. However, there is no teaching of tracking changes to physical documents, much less scanning a plurality of copies of a paper document and generating notation summary information that is in some way cognizant of the plurality of copies.

5. Jinnai

Jinnai also fails to teach or suggest these elements. Instead, Jinnai is directed at a facsimile machine that can store images of the documents. This facsimile machine can also read instructions from special "mark sheets." However, there is no teaching of tracking changes to physical documents, much less scanning a plurality of copies of a paper document and generating notation summary information that is in some way cognizant of the plurality of copies.

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6. Mooney

Mooney is directed at the detection and recognition of embedded identity information, such as a name and/or facsimile telephone number, in an imaged document for transmission, conversion of the recognized name, fax number or e-mail address into textual information, and automatic transmission of the imaged document to the fax number or e-mail indicated by the textual information. However, there is no teaching of tracking changes to physical documents, much less scanning a plurality of copies of a paper document and generating notation summary information that is in some way cognizant of the plurality of copies.

II. Conclusion

It is believed that the present application is in condition for allowance and a prompt and favorable allowance of all claims is respectfully requested. If the Examiner, upon considering this amendment, thinks that a telephone interview would be helpful in expediting allowance of the present application, he/she is respectfully urged to call the Applicant's attorney at the number listed below.

Respectfully submitted,

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